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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,936	09/25/2003	Fernando Cipullo	CIPLO.001A	2048

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT PAPER NUMBER

3712

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/670,936

**Applicant(s)**

CIPULLO, FERNANDO

**Examiner**

Vishu K Mendiratta

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Specification***

1. **NOTE:** It appears that claims 1-11 are only providing game pieces and a playing surface but no method steps whatsoever for how the game is being made. Applicant's preambles in claims 1-11 are not supported by limitations breathing life into the "making" aspect of the claims. As such claims 1-11 are being treated as apparatus claims for the purpose of this office action. Should the applicant decide to amend claims to include method steps to claim "a method of making (manufacturing) a game", a restriction will be required.

***Claim Rejections - 35 USC § 112***

2. Claims 1-11 provide for the use of making a game, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Claims 12-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the absence of proper structure of the apparatus it is not possible to practice a method. It is not clear how spaces are provided (in a path??) on a surface for players to move. Entire claim 12 is confusing due to limitations being in run-on sentence format. If a claim has more limitations than one, they should be properly separated and indented for clear meaning. It is not clear as to whether pieces move combined or separately or a roll total divided between both.

In claim 15, it is not clear with regards to the penalty awarded for keeping the pieces separated by "a predetermined number", which is the contrary of essential step of the method in claim 12 being "keeping the pieces separated within a predetermined number of spaces".

#### ***Double Patenting***

4. Applicant is advised that should claims 1-11 be found allowable, claims 16-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4,9-11,16,17 rejected under 35 U.S.C. 102(b) as being anticipated by Wooden (4226419).

Claims 1,16,17: Wooden teaches a game comprising game units of plurality of game pieces (70,80,90,100,110,111,112), a playing surface with path and spaces (3,4,5,6) sized to accommodate game units (Fig.6-7), and further providing rules for restricting movement of pieces (4:67-5:45).

**Applicant may note that rules for playing the game such as “restricting movement” do not further limit a game apparatus as claimed.**

Claims 2-3,9,10: Rules for playing do not further limit the apparatus in the claims.

Claims 4,11: Wooden teaches primary (70) and secondary (110,111,112) game pieces.

7. Claims 1-10,16-20 rejected under 35 U.S.C. 102(b) as being anticipated by Schick (3582080).

Claims 1,5-8,16-19: Schick teaches a game comprising game units of plurality of game pieces (Fig.5-6), a playing surface with path and spaces (pieces riding piggybacks) sized to accommodate game units (Fig.6-7) with a total of eight

Art Unit: 3712

pieces which are capable of being placed on one space as can be seen from picture that they are of flat configuration and can be stacked one over another, and further providing rules for restricting movement of pieces (4:7). Schick further teaches cards with numbers on them (Fig.10), images in an orientation (see cards 142, any indicia within the boundary line can be treated as indicia in orientation, in center and a rank).

**Applicant may note that rules for playing the game such as “indicating, restricting movement” do not further limit a game apparatus as claimed.**

Claims 2-3,9,10,20: Rules for playing do not further limit the apparatus in the claims.

Claims 4: Schick teaches primary (138) and secondary (137) game pieces.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Nuebling (4346899) in view of Williams (4903969).

Claims 12-13: Nuebling teaches a method of playing a board game selecting a primary (35) and a secondary (39) piece, placing them as a unit on a space (9:3-5), rolling a die and moving primary and secondary pieces (9:5-7), and keeping primary and secondary pieces within a predetermined number of

Art Unit: 3712

spaces (9:24-30). Applicant may note that drawing a card with a number is an art recognized chance device substitute for a dice with numbers, the method remaining the same.

Nuebling teaches all limitations except that it does not teach a combined move by primary and secondary pieces equaling a total of the card number.

Williams teaches a board game allowing a player to move multiple pieces to a total roll. Art area of board games is a competitive amusement area and in order to attract players it is obvious to allow such moves as already known in the art.

One of ordinary skill in art at the time the invention was made would have suggested combined move to a total roll.

Claim 14: Applicant may note that "pieces separated by a predetermined number being five" is a choice and would have been obvious for creating a variation.

Claim 15: Primary game piece imposed with penalty by leaving the primary game piece (33) on the same space when secondary piece is separated (9:23-24)

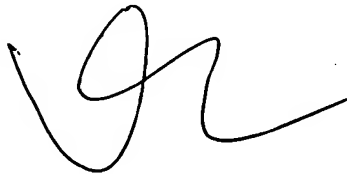
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (703) 308-1745. The

Art Unit: 3712

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a large, stylized 'V' followed by a series of loops and a long horizontal stroke extending to the right.

Vishu K Mendiratta  
Primary Examiner  
Art Unit 3712

VKM  
August 18, 2004